

# REMARKS

This is a simultaneous amendment with request for continued examination filed under 37 C.F.R. 1.114 in response to the Office Action dated January 23, 2009.

## I. SUBJECT MATTER OF THE NEW CLAIMS AND SUPPORTING DISCLOSURE

New claims 6 to 10 have been filed including one new independent claim 6. The previously pending claims 1 to 5 have been canceled.

The new independent claim 6 includes the features and limitations of both canceled claims 1 and 2. Thus the independent claim 6 is now limited to a hair color simulation system that displays both a first hair line and a second hair line that has a different pattern and color from the first hair line with predetermined transparencies on respective layers of the base screen. This feature permits the hair to be displayed in a more realistic fashion, as explained in the paragraph on page 6, between lines 4 and 20, of applicants' specification.

In addition, new independent claim 6 has further limitations provided in a two new last paragraphs, which are quoted here:

**“wherein the first layer, the intermediate layer, the second layer, the third layer, the fourth layer, and the fifth layer of the base screen are superimposed on one**

another so as to display a resultant simulated hair color that is produced when the first hair line, the second hair line, the colors of the hair color preparations and the original hair color are displayed on the respective layers of the base screen with the respective transparencies and superimposed on each other; whereby an actual hair color, which results from dyeing hair that has the selected hair color with a mixture of the selected two hair color preparations in the selected mixture ratio, is simulated”.

The aforesaid paragraphs describe additional distinguishing features of the claimed invention and are supported by the disclosures in the paragraphs on page 7, between lines 10 and 30, and the last paragraph on page 3, of applicants’ originally filed English translation. These additional distinguishing features of the invention are that the respective layers of the system are arranged or superimposed over each other and the colors of the chosen input two hair color preparations displayed on the layers are superimposed over each other on the layers with respective transparencies according to a chosen input mixing ratio and that the resulting mixed color is superimposed over an originally hair color on the respective layers of a base screen with an empirically determined transparency, so that when an individual looks at the base screen he or she observes their own hairstyle with a simulated hair color due to the mixing the superimposed colors over each other.

Then if the individual likes the simulated color of the hairstyle, the hairstyling professional can perform a dyeing procedure to dye the individual’s hair by mixing the actual hair color preparations with the mixing ratio that was chosen in the simulation process.

A new claim 10 claims a preferred embodiment that relies on the aforesaid features of canceled claims 1 and 2 in the new independent claim 6. According to the preferred embodiment of claim 10 the hair images of the hair are displayed three-dimensionally for a more realistic simulation of the hairstyle. The subject matter of claim 10 is entirely new and is supported by the disclosure on page 6, lines 8 to 12, of the applicants' specification.

New dependent claims 7, 8, and 9 contain the subject matter of canceled claims 3, 4, and 5. However no substantial changes have been made in the wording of these dependent claims.

## **II. NEW ABSTRACT**

A new abstract replaces the previously filed abstract in the amendment dated February 18, 2008. The new abstract is less than 150 words and describes the claimed invention including the new limitations added to the independent claim.

## **III. INDEFINITENESS REJECTION**

Claims 1 to 5 were rejected under 35 U.S.C. 112, second paragraph, for indefiniteness.

New claims 6 to 10 have been filed and claims 1 to 5 have been canceled.

The new independent claim 6 and the dependent claims have been checked to determine whether all the recited claim limitations have sufficient

antecedent basis. It is believed that there is sufficient antecedent basis for all claim limitations provided in the new claims 6 to 10.

In view of the aforesaid reasons it is respectfully submitted that new claims 6 to 10 should not be rejected as indefinite under 35 U.S.C. 112, second paragraph.

#### **IV. OBVIOUSNESS REJECTION**

Claims 1 to 5 were rejected as obvious under 35 U.S.C. 103 (a) over Saita (US '565), in view of Hamburg (US '583), in view of Fertig (US '689), and further in view of Yoshio (US '306).

New claims 6 to 10 have been filed and claims 1 to 5 have been canceled. The new independent claim 6 includes critical new distinguishing limitations including the following limitations (which were also quoted above):

**“wherein the first layer, the intermediate layer, the second layer, the third layer, the fourth layer, and the fifth layer of the base screen are superimposed on one another so as to display a resultant simulated hair color that is produced when the first hair line, the second hair line, the colors of the hair color preparations and the original hair color are displayed on the respective layers of the base screen with the respective transparencies and superimposed on each other; whereby an actual hair color, which results from dyeing hair that has the selected hair color with a mixture of the selected two hair color preparations in the selected mixture ratio, is simulated”.**

The aforesaid paragraphs describe additional distinguishing features of the claimed invention and are supported by the disclosures in the paragraphs on

page 7, between lines 10 and 30, and the last paragraph on page 3, of applicants' originally filed English translation. The original independent claim 1 did not state that the layers of the base screen are superimposed over each other or that colors of the hair color preparations and the original hair were superimposed over each other with respective transparencies so that a resulting simulated color is observed by an individual that views the base screen.

Furthermore the new independent claim 6 includes the features of canceled claim 2 as well as canceled claim 1. These features facilitate a realistic impression for the simulated hairstyle that is displayed on the base screen with the simulated hair color, as explained above and in the first full paragraph on page 6 of the specification.

Section A describing the scope and content of the Saita, Hamburg, Fertig and Yoshio U.S. Patents that appears on pages 8 to 14 of the amendment filed on October 24, 2008 will not be repeated here. Reference is made to that section and the contents of section A of the previous amendment are included here by reference thereto.

Hamburg does disclose a general method of compositing an ordered set of image layers to provide a combined impression or effect or final image (Abstract, claim 1). However Hamburg does not limit the content of the image layers or disclose that the layers have images of hair, hair colors, or of an individual's head or hairstyle.

Hamburg does not disclose or suggest that the respective individual superimposed layers include corresponding images of a first hair line, a second hair line that has a different pattern and color from the first hair line, an original color of an individuals' hair that is to be colored, a color produced by a first hair dye preparation, and a color produced by a second hair dye preparation with respective transparencies.

In other words, Hamburg suggests a generic method for combining images with different colors and other characteristics but does not disclose or suggest combining the layers including the five specific images according to applicants' new claim 6.

A broad generic disclosure does not necessarily make a more limited species obvious. See M.P.E.P. 2144.08.

In fact, there is nothing in Hamburg that would lead one skilled in the hair dyeing arts to include the two different colors produced by two different hair dyeing compositions on two different layers of their combined layer.

Referring to the two cited prior art references that actually teach systems for simulating colors of dyed hair, Saita teaches displaying an image of the head of an individual with hair of a single color on a single layer (base screen) or displaying multiple images side-by-side with hair of different colors. Saita provides no reason to superimpose these multiple images to make a composite image as in Hamburg. Saita does not recognize any benefits or advantages to superimposing images with different hair colors or lead one to do that.

Saita further suggests that their system contains a database containing information regarding hair coloring preparations. There is a one-to-one relationship between the hair coloring preparations and the color that they produce when applied to the hair according to Saita (column 5, lines 13 to 27, and last paragraph column 4).

Thus Saita would not lead one skilled in the art to superpose colors produced by different hair coloring preparations. Saita would not lead one skilled in the hair coloring arts to provide an image of an individual's head with hair of one color on a first of Hamburg's layers and another image of the individual's head with hair of another color on a second of Hamburg's layers that is superimposed with the first layer. Also Saita would not suggest providing two layers of Hamburg with different hair colors and superposing them for any reason, because Saita assumes that the resulting hair color is displayed and is associated with a single hair coloring preparation.

Fertig, the other hair color simulation reference, teaches nothing more than Saita regarding simulation of the results of mixing of hair coloring preparations and dyeing hair with the mixture. Fertig teaches a somewhat more realistic method of simulating the results of dyeing hair with a single hair coloring preparation, in which a TV camera is used to capture the image of a person's head and display it on a TV screen (figs. 1 and 2). The individual may turn his head at different angles and thus view his or her image from different angles in the TV screen as if viewing his or her image in a mirror. A computer modifies the displayed image in real time so that only the color of the head hair is changed to

various colors so that the individual can choose the color that suits him or her best.

Fertig however does not explain how one skilled in the art would prepare or select a hair coloring preparation or preparations that would produce the color that the individual finds most suitable. Saita of course explains that their processor includes a database that associates the selected color with one or perhaps more than one hair coloring preparation, which is then used to color the hair. Saita also discloses an embodiment in which other criteria are used to select the single hair coloring preparation that is used to color the hair (last paragraph of column 4 of Saita).

Neither Saita nor Fertig suggests or discloses the two superimposed layers comprising superimposed images with different hair colors as claimed in applicants' new claim 6, because such superimposed images are not necessary in their simulation methods.

Thus one skilled in the art would not be motivated to combine the disclosures of Saita and of Fertig with those of Hamburg.

Yoshio certainly does disclose an image processing method and apparatus for displaying color images of an individual on figures 5 and 6, who has head hair. Also fig. 5 shows sliders for adjusting brightness and contrast of the images. Fig. 6 shows buttons for adjusting the contribution of various color hues to the color of the image as a whole. This sort of image processing is used in photography to correct the contrast, brightness and color of a color photograph.



However a combination of Yoshio with Saita and Fertig also does not lead to the inventive system as it is now claimed in claim 6. Yoshio would perhaps suggest a system or apparatus with a slider or buttons as shown in figs. 5 and 6 of Yoshio in order to rapidly adjust the color of the head hair of the images displayed on the display screens of Saita and Fertig. This would allow the user to select his preferred color rapidly and efficiently.

But this combination does not provide any information regarding mixing of two dye preparations that produce different colors when applied individually to the hair. It only allows one to select the chose color efficiently. Yoshio does not disclose or suggest that the color buttons of fig. 6 or that the slider is associated with a mixture ratio of two coloring preparations or that respective transparencies of colors on superimposed layers are controlled to represent a mixture ratio of two actual hair coloring preparations. There is no discussion of adjusting or mixing anything but color hues in Yoshio.

None of the prior art reference disclose a simulation system for selecting a mixture ratio of hair coloring preparations to be used in an actual hair coloring procedure based on a choice of a desired hair color that results from superposition of layers with images of the respective colors produced by the individual hair color preparations.

When analyzing the relationship of a claimed invention to the disclosures in multiple prior art references care must be taken not read applicants' limitations from their independent claim into the prior art disclosures from the applicants' specification.

It is especially important to remember that the 35 U.S.C. 103 (a) requires that the source of the reason for combining the disclosures of the prior art references to arrive at the claimed invention cannot be the applicants' specification and that the references and the reason must have been apparent at the time the invention was made by the inventor, i.e. at least the application date. For example, the Federal Circuit Court of Appeals has said:

“As in all determinations under 35 U.S.C. 103, the decision-maker must bring judgment to bear. It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selected elements from references to fill the gaps”. *In re Gorman*, 18 U.S.P.Q.2d 1885 (Fed. Cir. 1991).

In the case of the instant invention Hamburg certainly would suggest a method in which images of various colors in their compound layers are combined to make a composite image. However Hamburg does not teach or lead one skilled in the art to superposed layers comprising the images as claimed in applicants' claim 6 with the respective transparencies.

Fertig and Saita would not lead one familiar with the disclosures of Hamburg to superimpose two layers each having the respectively colors that are separately produced in separate hair coloring procedures with different hair coloring compositions. The reason is Fertig and Saita are solely concerned with selection of a single desired color. Then they teach picking a single hair coloring composition for producing the single color, not mixing two hair dye compositions. For that reason they do not suggest two superimposed layers as in Hamburg with two different colors to produce a resulting simulated color.

Yoshio teaches nothing more than methods of adjusting or mixing colors or color shades to display a mixed color.

A combination of Hamburg with Fertig, Saito and Yoshio does not lead one skilled in the art to a simulation method for determining a mixture ratio of two different hair coloring preparations that are mixed to produce a predetermined hair color that is produced when a mixture of the hair coloring preparations is applied to the hair.

Furthermore the combined disclosures of the prior art references of record do not lead one skilled in the art to provide two layers with two different hair lines which are superimposed with the original hair color with a suitable transparency and then with the two layers with the colors produced by the individual hair coloring preparations.

The feature of blending the dyed hair colors with the original hair color with suitable transparencies on plural layers is not apparent from the combined prior art.

Similarly the feature that the two hair lines are combined to provide a more realistic image of the hair with individual hair images is not disclosed or suggested by the combined prior art. From the standpoint of Hamburg no superimposed layers are suggested that comprise the two hair line images and Saita and Fertig provide no reasons for doing that. This feature and the preferred embodiment of claim 10 is simply absent totally from the combined disclosure of the prior art.

For the aforesaid reasons it is respectfully submitted that new claims 6 to 10 should **not** be rejected as obvious under 35 U.S.C. 103 (a) over Saita (US '565), in view of Hamburg (US '583), in view of Fertig (US '689), and further in view of Yoshio (US '306).

Should the Examiner require or consider it advisable that the specification, claims and/or drawing be further amended or corrected in formal respects to put this case in condition for final allowance, then it is requested that such amendments or corrections be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing the case to allowance, he or she is invited to telephone the undersigned at 1-631-549-4700.

In view of the foregoing, favorable allowance is respectfully solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael J. Striker", with a long, sweeping horizontal stroke extending to the right.

Attorney for the Applicants

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